

USSN: 09/770,960

Atty. Docket No.: 10247

Response dated April 8, 2005

Reply to Final Office Action of February 8, 2005

REMARKS/ARGUMENTS

Claims 1-23 and 27-29 are all the claims pending in the application.

Referring to Section Nos. 1-4 at page 2 of the final Office Action, Applicants note with appreciation the Examiner's indication of withdrawn rejections.

The final Office Action contains the following rejections at Section Nos. 6 and 8:

Claims 1-7, 10-21, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,965,123 ("US '123"); and

Claims 8-9, 22-23, and 28-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US '123 in view of U.S. Patent 5,888,640 ("US '640").

In support of the rejections, the Examiner presents at Section Nos. 9 and 10 (page 6) of the final Office Action detailed comments specific to the amendments and arguments presented in the Amendment filed November 22, 2004. In particular, the Examiner states at Section 10 that "[t]he declaration under 37 C.F.R. § 1.132 filed 11/22/04 is insufficient to overcome the rejection of claim 1 ... because: a declaration filed under 37 C.F.R. § 1.132 cannot overcome a 102(b) rejection. See MPEP 706.02(b)."

Applicants respectfully traverse the rejections. The Declaration of Ms. Squier filed November 22, 2004, should have been considered and renders the presently claimed invention patentable over the rejections based on US '123 and US '123 in view of US '640.

The Declaration of Ms. Squier filed November 22, 2004, should have been considered.

It appears that the Examiner considers a Rule 132 Declaration to be specifically reserved for the submission of evidence of secondary considerations relevant to a §103 rejection. For example, it appears that the Examiner has taken the statement at MPEP §2131.04 and applied it to preclude consideration of Ms. Squier's Declaration in the present case.

Rule 132 Declarations are not so limited, however, and Ms. Squier's Declaration includes evidence in the form of testimony from one of ordinary skill in the art which demonstrates that

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one of ordinary skill in the art would understand that the term "cold glue adhesive" in the present claims excludes the pressure-sensitive adhesives disclosed in US '123. Specifically, 37 C.F.R. § 1.132 provides that "[w]hen any claim of an application ... is rejected or objected to, *any evidence* submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section." (Emphasis added.) Thus, Rule 132 is a general rule for submission of many different types of evidence of patentability; it is not limited to the submission of evidence of secondary considerations.

The reason for providing evidence in declaration or affidavit form is to provide the Examiner with an assurance that any statement or representation in the declaration or affidavit is correct, as provided by 18 U.S.C. 1001. This is the precise reason why Ms. Squier submitted her Rule 132 Declaration. Furthermore, she wanted to distinguish her comments from mere attorney argument and clarify for the Examiner the interpretation that one of ordinary skill in the art would lend to the term "cold glue adhesive" in the claims of the present invention.

In short, Ms. Squier's Declaration filed November 22, 2004, must be considered as evidence of the proper construction of the term "cold glue adhesive" in the present claims.

When properly considered, Ms. Squier's Declaration renders the presently claimed invention patentable over the rejections based on US '123 and US '123 in view of US '640.

In this regard, similar to the distinction made between "cold glue adhesive" and "cold seal adhesive" in the Declaration filed May 25, 2004, the present Declaration leads to the conclusion that the term "cold glue adhesive" is understood by those of ordinary skill in the art as referring to a class of materials distinct from and not including "pressure-sensitive adhesives." In particular, the different functional applications of cold glue adhesives and pressure-sensitive adhesives necessitate that cold glue adhesives and pressure-sensitive adhesives have different formulations which result in cold glue adhesives having different inherent properties from pressure-sensitive adhesives.

Because the terms "cold glue adhesive" and "pressure-sensitive adhesive" refer to different classes of materials, the term "cold glue adhesive" in the present claims does not

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encompass the pressure-sensitive adhesives disclosed in US '123. Accordingly, US '123 does not disclose (anticipate) the claimed invention.

Furthermore, it would not have been obvious to modify US '123, either by reference to itself or US '640, and arrive at the claimed invention.

There must be some motivation or suggestion to make the claimed invention in light of the prior art teachings. The mere possibility that the prior art may be modified so as to arrive at the claimed invention does not render obvious the invention unless the prior art suggested the desirability of the modification. The suggestion to modify must be "clear and particular." In re Sang Su Lee, 2002 U.S. App. LEXIS 855 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

In the present case, none of US '123 and US '640 provides any motivation or suggestion to arrive at the claimed label with cold glue adhesive. None of US '123 and US '640 provides any reason to replace a pressure-sensitive adhesive with a cold glue adhesive.

Also, cold glue adhesives and pressure-sensitive adhesives have different functional applications which necessitate that cold glue adhesives and pressure-sensitive adhesives have different formulations and inherent properties. Therefore, a person of ordinary skill in the art would never have modified US '123 by replacing the pressure-sensitive adhesives of US '123 with cold glue adhesives.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the remaining §102 and §103 rejections.

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Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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